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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,748	08/19/2003	Joel D. Oxman	58614US002	4133
32692	7590	02/23/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			WILSON, JOHN J	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,748

Applicant(s)

OXMAN ET AL.

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/5/04 5/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: IDS Continued: 1/13/05 1/24/05 4/14/05 6/15/05.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, 11, 16, 17, 22, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Neustadter (3565387). Neustadter teaches an article form comprising an organic composition, column 2, lines 40-48, that is malleable, column 2, lines 54-57. The shown structure is inherently capable of being filled and removed, and therefore, all of the actual claimed structure being shown, the intended method of use is given no patentable weight. As to claim 2, the compositions disclosed at column 2, lines 40-48 are inherently curable. The intended time of curing or not curing is a matter of the method of making or using, and as such, is given no patentable weight. As to claims 4 and 5, Neustadter teaches polyvinylacetate, column 2, line 46. As to claim 24, the shown structure is capable of not being removed depending on the method of use, and therefore, meets the actual claimed structure. As to claim 26, the shown structure is capable of being removed after partial hardening depending on the method of use, and therefore, meets the actual claimed structure.

Claims 39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Simor (3585723). Simor shows the method steps of selecting an article form 10,

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column 5, lines 53-55, filling the form with a hardenable material, column 6, lines 21-25, placing the form on a tooth, column 6, lines 26-29, hardening the material, column 1, lines 66-71, cementing to the tooth as shown and reshaping the article form in the subject's mouth, column 6, lines 55-58, and column 8, lines 65-71. Optional method steps include the option of not being preformed, and as such, are inherently met by the shown method. As to claim 40, this claim does not specify what the article form is being removed from, and as such, is met by the teaching of Simor to remove the form, column 6, lines 21-25.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 28-33, 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neustadter (3565387). Neustadter shows all of the structure as described above including the use of plastics, the specific type of resin used, including the not using a filler material, is an obvious matter of choice in the type of plastic used to obtain the desired properties.

Claims 6-9 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neustadter (3565387) in view of Wilson (5487663). Neustadter shows the structure as described above, however, does not show the use of a filler. Wilson teaches using a filler, column 4, lines 34-47. It would be obvious to one of ordinary skill in the art to modify Neustadter to include the use of a filler as shown by Wilson in order to obtain the desired strength needed for a prosthesis. As to claims 7-9 and 19-21, the specific type of filler used is an obvious matter of choice in known fillers for obtaining known properties within the resin.

Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neustadter (3565387) in view of Adair (4431420). Neustadter shows the elements as described above, however, does not show the use of a surfactant. Adair teaches using a surfactant, column 8, line 7. It would be obvious to one of ordinary skill in the art to modify Neustadter to include the use of a surfactant as shown by Adair in order to minimize the thickness.

Claims 12, 23 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neustadter (3565387) in view of Pierson (5951294). Neustadter shows the elements as described above, however, does not show a reservoir of material. Pierson shows a reservoir of material in Fig. 6. It would be obvious to one of ordinary skill in the art to modify Neustadter to include a reservoir as shown by Pierson in order to supply the filling material needed to the form.

Claims 13, 14, 25 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neustadter (3565387) in view of Uthoff (5102332). Neustadter shows the elements as described above, however, does not show using a package that can block light. Uthoff teaches using a package 2 that can block light. It would be obvious to one of ordinary skill in the art to modify Neustadter to include a package as shown by Uthoff in order to ship and protect the article.

Claims 15, 27 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neustadter (3565387) in view of Kahn (3949476). Neustadter shows the elements as described above, however, does not show a handle. Kahn teaches using a handle 18, column 2, lines 29-34. It would be obvious to one of ordinary skill in the art to modify Neustadter to include a handle as shown by Kahn in order to better manipulate the article in the mouth.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simor (3585723) in view of Kennedy (4129946). If the limitation of removed is given the meaning that the form is removed from the filling material, then, Simor shows the method steps as described above, however, does not show removing the form. Kennedy teaches the known method of using a form and then removing it. It would be obvious to one of ordinary skill in the art to modify Simor to include removing the form as shown by Kennedy in order to obtain the desired shape and size.

Claims 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simor (3585723) in view of Neustadter (3565387). Simor shows the method steps as described above and further teaches using a deformable plastic, column 4, line 72, through column 5, line 1, however, Simor does state the type of plastic used. Neustadter teaches using polyvinylacetate, column 2, line 46. It would be obvious to one of ordinary skill in the art to modify Simor to include the malleable plastic as taught by Neustadter in order to make use of known deformable materials for article forms. The specific type of plastic used is an obvious matter of choice in known plastics to obtain desired properties to the skilled artisan. As to claim 44, the state of curing of the form is an obvious matter of choice in curing the material to the desired degree to obtain the desired properties to one of ordinary skill in the art.

Claims 1-44 are rejected under 35 U.S.C. 103(a) as being obvious over Karim et al (2003/0114553) in view of Neustadter (3565387).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed

in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Karim teaches using an organic composition that is self-supporting and malleable. Karim does not show using a form that is capable of being filled. Neustadter teaches using a form that is capable of being filled. It would be obvious to one of ordinary skill in the art to modify Karim to include a form as shown by Neustadter in order to obtain the desired size and shape. To include a reservoir of material would have been obvious in order to supply the needed filling material. The specific material used is an obvious matter of choice in known plastics to the skilled artisan. To use a handle would have been obvious to one of ordinary skill in the art in order to better manipulate the form.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-78 of copending Application No. 10/219,398 in view of Neustadter (3565387). The claims of the '398 application teach using an organic composition that is self-supporting and malleable, however, do not show using a form that is capable of being filled. Neustadter teaches using a form that is capable of being filled. It would be obvious to one of ordinary skill in the art to modify the '398 claims to include a form as shown by Neustadter in order to obtain the desired size and shape. To include a reservoir of material would have been obvious in order to supply the needed filling material. The specific material used is an obvious matter of choice in known plastics to the skilled artisan. To use a handle would have been obvious to one of ordinary skill in the art in order to better manipulate the form.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Drawings

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosellini (5332390) shows a form and method for making a prosthesis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
February 17, 2006